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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,036	07/09/2001	Toyohiko Ushiku	862.C2297	3930
5514	7590	03/01/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			HARRELL, ROBERT B	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	

2142

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/900,036

**Applicant(s)**

USHIKU, TOYOHICO

**Examiner**

Robert B. Harrell

**Art Unit**

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 15-24 and 29 is/are pending in the application.  
4a) Of the above claim(s) 11-14, 25-28 and 30 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10, 15-24 and 29 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 7/9/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☒ Other: see attached Office Action.

Art Unit: 2142

1. Claims 1-30 are presented for consideration.
2. Claims 1-10, 15-24, and 29 have been elected, with traverse, by the applicant in his election response of October 25, 2004. The applicant argued the traversal by stating in substance that
  - a) it is noted that Claims 1 to 5 are system claims that include various components which make up the system, which component parts are claimed in Claims 6 to 10, 11 and 12, and 13 and 14, respectively. For example, the apparatus of Claim 6 can be seen to perform the functions of the acquisition means, setting means, and transfer means of Claim 1. However, claim 6 is within the set of elected claims not restricted from that set. Hence, this argument is moot;
  - b) the apparatus of Claim 11 can be seen to perform the functions of the service use means of Claim 1. However, claim 11 is void the acquisition means, the setting means, and transfer means, in part, as found in claim 1 while claim 1 is void of the service providing means and reception means, in part, as found in claim 11. There is, thus, a two way distinction between these two claims and thus different inventions;
  - c) additionally, Claim 13 may be seen to correspond to the second service providing device of Claim 1. However, claim 13 is void the acquisition means, the setting means, and transfer means, in part, as found in claim 1 while claim 1 is absent proxy limitations, in part, of claim 13. There is, thus, a two way distinction between these two claims and thus different inventions.
3. Thus per the restriction above, the features of each of the component group of claims can be seen not to be included in those of the other group of claims. As such, a search for the Group I claims would not encompass a search for the remaining groups. As such, examination of all of the claims in a single application would present a serious burden on the Examiner since the examiner would be searching more than one invention and thus be conducting more than one examination. Accordingly, reconsideration of the restriction requirement and examination of all of the claims on the merits has been considered but the restriction considered proper, in light of these arguments, and thus made FINAL.
4. Claims 11-14, 25-28 and 30 have been withdrawn for the reasons outlined above. However, the applicant is reminded that continued prosecution of these claims may be continued in/by filing a divisional application.
5. Claims 1-10, 15-24, and 29 remain for examination for the reasons outlined above.
6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
7. The textual portion of the specification is replete with grammatical and idiomatic errors too numerous to mention specifically. For example, page 1 (line 18) misspelled "Sun". Also, the Abstract should not use "A" as a variable; nor "X" as such would imply "X Windows". Rather, the Abstract should use phrase such as "When Service N is provided by a Service Provider M is

Art Unit: 2142

accompanied by the use of an accounting service...". The whole of the application should be revised carefully.

8. Pages 1-6 would suggest figures 12, 13, 14, and 15 are prior art. However, such figures are not so labeled. Thus the figures and the specification are objected to since they do not have corresponding status with respect to Prior Art. Correction is required.

9. For the reasons outlined above, the applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks <sup>TM</sup>, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims. Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

10. The following is a quotation of the second paragraph of 35 U.S.C 112:

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

11. Claims 1-10, 15-24, and 29 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear as indicated below.

12. "the user information registered"--claim 2 (lines 1-2)[claim 1 makes no reference to a **registration** act] is but an example of numerous cases where clear antecedent bases is lacking and not an exhausting recital. Any other term(s) or phrase(s) over looked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent bases also is indefinite for the reasons outlined in this paragraph. Also, this is but an example where term(s) or phrase(s) are introduced more than once without adequate use of either "the" or "said" for the subsequent use of the term(s) or phrase(s). Moreover, multiple introduction of a term, or changes in tense, results in a lack of clear antecedent bases for term(s) or phrase(s) which relied upon the introduced term (for example "the acquisition step" of claims 15 and 20 (line 3) and claim 29 (line 5)). Failure to correct all existing cases where clear antecedent bases are lacking can be viewed as non-responsive.

13. Per claim 1, the location of the network cannot be clearly ascertained. The claim recites a network "in" a user device, however such is not disclosed (i.e., a network inside of a user device rather outside to which the user device is connected). Thus it cannot be clearly ascertained if the user device has a network therein or if the user device is connected to an external network external from inside the user device (i.e., network inside or outside of the device).

Art Unit: 2142

14. Per claims 1-10, 15-24, and 29, there is recited an acquisition means for acquiring a first service object and then does nothing with the first service object. Thus examiner is not able to clearly ascertain if the claimed user information set into the second service object is obtained from the first service object since, after all, the first service object has been fetched for some yet to be claimed reason. That is, it cannot be clearly ascertained if information is taken from the first object, or elsewhere, and entered into the second object which second object is then sent back to the first service providing device (i.e., and not limiting the claims hereto automated form filling), or some other act performed within the recited system.

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

**A person shall be entitled to a patent unless -**

**(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;**

16. Claims 1-10, 15-24, and 29 are rejected under 35 U.S.C. 102 (e) as being anticipated by Gupta et al. (US 6,199,079 B1).

17. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

18. Per claim 1, Gupta taught an information processing system comprising:

a) acquisition means for acquiring a first service object (e.g., see Abstract, figure 3B (322) items for sale)) from a first service providing device (e.g., see figure 1C (Site 1-Site N) and col. 6 (line 18)) and a second service object (e.g., a form to be filled per Abstract) from a second service providing device (e.g., see 6 (line 55-et seq.)) via a network (e.g., see figure 1A (45) and Abstract ("Internet"));

b) setting means (e.g., see figure 3C (344)) for setting user information in the second service object (e.g., a form) acquired by said acquisition means in the user device, and causing the second service object to hold the user information (e.g., see col. 7 (line 65-et seq.)) ;

Art Unit: 2142

c) transfer means (e.g., see col. 8 (line 55-et seq.)) for transferring the second service object which holds the user information to the first service providing device; and,

d) service use means for providing a service of the second service providing device to the first service providing device by causing the second service object transferred to the first service providing device to use the user information (e.g., that is the filled in order form containing user information is filled by the merchants per col. ).

19. Per claim 2, since there is no direct link between the merchants and the user information as stored, the user information registered in the second service object transferred by said transfer means cannot be referred to by the first service providing device.

20. Per claim 3, wherein said acquisition means comprises at least one server arranged on the network to register service objects provided by a plurality of service providing devices, and searches for and acquires a desired service object from the server per figure 3A (312) as an example and/or 322 in figure 3B as another example.

21. Per claim 4, wherein the system further comprises ID acquisition means for acquiring a session ID in the user device as shown in figure 1D (92) per col. 6 (lines 28-55).

22. Per claim 5, the word "encrypt" reaches binary encoded data; that is, data is stored on hard disk in ASCII binary (bits) at the minimum. Also, such was anticipated as personal information should never become in the hands of hackers looking to commit identity theft.

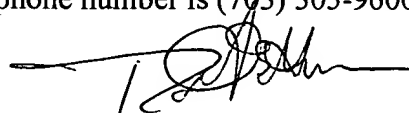
23. Per claims 6,7,8,9,10,15,16,17,18,19,20,21,22,23,24, and 29, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above.

24. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (571) 272-3896. The fax phone number for all papers is (703) 872-9306.

27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL  
PRIMARY EXAMINER